



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,681	09/01/2000	Akio Fukushima	16869P-012100US	5326

20350 7590 06/21/2004

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

VENT, JAMIE J

ART UNIT	PAPER NUMBER
----------	--------------

2613

DATE MAILED: 06/21/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,681

Applicant(s)

FUKUSHIMA ET AL.

Examiner

Jamie Vent

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,7,14,15,16,17,18,19,20, and 21 are rejected under 35 U.S.C. 102(b) as being unpatentable by Yamagata et al (US 5,856,460).

[claims 1 & 18]

In regard to Claims 1 and 18, Yamagata et al discloses an apparatus for playing back first data having audio information, visual information, or audio-visual information the first data containing second data, the apparatus comprising:

- Reproduction processing circuit configured to produce the first data (Figure 10 reproduction amplifier and the frequency demodulation circuit sends the reproduction signal to a the reproduced signal discrimination circuit 123);
- Data store configured to receive at least some of the first data (Figure 10 shows memory 117 as the data store which receives the first data from straight from the A/D/ Conversion Circuit 116 or via the system controller 128 as further described in Column 9 Lines 5-15);
- Detecting circuit coupled to the data store and configured to process data contained therein to produce a detection result, the detection result being based at least on the second data (Figure 10 reproduced signal discrimination circuit 123 detects from the

reproduced signal is video or some other signal and is thereby coupled to the memory via the system/memory controller); and

- Control circuit configured to selectively output the first data based on the detection result (Figure 10 system controller 128 selectively outputs the data to the RAM or the memory controller as further stated in Column 9 Lines 30 – 62).

[claim 7]

In regard to Claim 7, Yamagata et al discloses an apparatus wherein a data bus coupled only between the detection circuit and the control circuit, wherein the detection circuit produces a signal representative of the detection result, the signal being sent to the control circuit via the data bus (Figure 10 shows the coupling of the detection circuit/ reproduced signal discrimination circuit 123 and the control circuit/ system controller 128 is connected via a data bus).

[claims 14 & 15]

In regard to Claims 14 and 15, Yamagata et al disclose an apparatus wherein the data store receives at least some of the first data at a data rate at which the reproduction processing circuit produces the first data and is configured to output data contained therein at the same time it receives at least some of the first data (Column 16 describes the output data (Column 16 Lines 20-55 describes the data rate in which reading action from the memory/data store is produced and furthermore describes the outputting of data at the same time it receives the first data).

[claim 16]

In regard to Claim 16, Yamagata et al disclose an apparatus wherein the data store receives at least some of the first data at a first data rate equal to a data rate at which the reproduction processing circuit produces the first data, wherein the detecting circuit is configured to produce a

signal indicating a second data raw and to output the data contained therein at the second data rate in response to the second signal (Column 9 Lines 65-68 and Column 10 Lines 1-12 describes the time-base compression rate of the audio and video signals and at which the reproduction circuit produces the data as well as the detecting circuit producing the second data in response to the signal that is detected).

[claim 17]

In regard to Claim 17, Yamagata et al disclose an apparatus wherein the detecting circuit is configured to receive data contained in the data store at a third data rate and process the data to produce a detection result at a different data rate, wherein the data rates are equal to or greater than the third data rate (Figure 11 S40 shows the storing of reproduction control data in the memory/data store. Furthermore, in Column 10 Line 23-30 describes the demodulation of data wherein the flag is detected on the basis of a pulse signal which is sent to the timing signal generating circuit thereby the circuit forms timing pulse signal on the bases of the detection signal and sends it to the control circuit. The process of receiving the data from the memory and producing the data is all done within the data rate established by the elements described above).

[claim 19]

In regard to Claim 19, Yamagata et al discloses a method for accessing first data having audio information, visual information, or audio-visual information, the first data containing second data, the method comprising:

- receiving the first data from a data source (Figure 1 shows receiving of data from the magnetic disk 1);

- storing the first data in a data store (Figure 10 shows the data being stored in memory 117);
- producing a detection result by processing data in the data store, the detection result based at least on the second data (Figure 10 shows the detection of the second data being audio and the result of the audio being sent for output to the audio signal processing circuit 119); and
- selectively outputting the first data based on the detection result (Figure 10 the system controller 128 selectively determines what will be outputted to the RAM 129, ROM, 130, memory 117 or frame memory 128 for storage and/or further output through the monitor 15 and speaker 121).

[claim 20]

In regard to Claim 20, Yamagata et al discloses a method wherein selectively outputting is further based on the type of data source (Figure 10 shows output via the monitor for video signal and speaker for audio thereby the output is based on the data source (audio or video data streams)).

[claim 21]

In regard to Claim 21, Yamagata et al discloses an apparatus for playing back first data having audio information, visual information, or audio-visual information, the first data containing second data, the apparatus comprising:

- first means for providing the first data from a data source (Figure 10 shows reproduction amplifier 11 which provides the first data from the magnetic disk medium);

- second means, coupled to the first means, for storing at least some of the first data (Figure 10 shows storage means through memory 117);
- third means for producing a detection result, including means for processing data stored in the second means (Figure 10 reproduced signal discrimination circuit produces a detection result which is sent to the system controller 128 which further processes the data); and
- fourth means operatively coupled to the third means, for outputting the first data based on the detection circuit (Figure 10 shows the output from the system controller to the frame memory and via the monitor 15 for output if the data is video and output to the speaker 121 if the data being processed is audio).

****Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,3,4,5,6, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagata et al (US 5,856,460) in view of Fujinami et al (US 6,192,189).

[claims 2, 4, & 5]

In regard to Claims 2, 4, and 5, Yamagata et al discloses a reproducing apparatus but lacks the following:

Art Unit: 2613

- a data selection circuit configured to select a first data subset (I-picture) of the first data, the data selection circuit coupled to deliver the first data subset (I-picture) to the data store, wherein the detecting circuit processes the first data subset (I-picture);
- produce a signal indicating the completion of processing of the first subset (I-picture), wherein the selection circuit selects, in response to the signal, a second data subset of the first data, and wherein the second data subset replaces the first data subset (I-picture);

Fujinami et al discloses a data recording method and apparatus (Figure 1) in which the apparatus has an entry point detection circuit 31 which selects the entry point/I-picture before sending into the apparatus data store in a form of the code buffer 4 wherein the I-picture is sent to be processed by the detecting circuit/controller 8, as described in Column 7 Lines 54+. Fujinami et al further discloses the entry point generating signal generates a signal when the process is completed as described in Column 8 Lines 6-14 describes the generation of the signal as well as the selection of a second subset of data as seen in Figure 1 the selection between the various code buffers through points E1, E2, E3, E4, and E5 provide the selection of additional data from the stored contents in the code buffers as instructed by the entry point detection circuit 31 via the controller 8.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to use the reproducing apparatus as disclosed by Yamagata et al and incorporate a data selection circuit for selecting the first data subset for storage, display, or editing of the data, as disclosed by Fujinami et al, which allows for more control of over the data for reproducing functions.

[claim 3]

In regard to Claim 3, Yamagata et al fails to disclose an apparatus wherein the capacity of the data store is equal to or greater than the maximum size of the first data subset. The examiner takes official notice that it is well known in the art that buffer size is set an amount with the processed data, such as I-frame, for proper decoding. It would be obvious to one skilled in the art at the time of the invention for Yamagata et al to set the capacity of the data store to be equal or greater than the maximum size of the first I-frame, as it is well known a data store with the proper size for data allows for proper decoding.

[claims 6 & 13]

In regard to Claims 6 and 13, Yamagata et al discloses a reproducing apparatus with first subset of data; however, fails to fails to disclose discloses an apparatus wherein the first data is an ISO-MPEG 2 formatted data stream, and wherein the first data subset is an I-picture. Fujinami et al discloses a system where the first data is ISO-MPEG 2 formatted data stream (Column 8 Line 63) and the first data subset is an I-picture (Column 8 Line 7).

Therefore, it would be obvious to one skilled in the art at the time of the invention to disclose the first data to be an ISO-MPEG 2 formatted data stream as well as the first data subset to be an I-picture as disclosed by Fujinami et al, as it is well known in the art for data streams to adhere to the MPEG standard as well as data streams containing an I-picture.

Claims 8, 9, 10, 11, and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagata et al (US 5,856,460) in view of Copeland et al (US 5,659,613).

[claims 8, 9, 10, 11, & 12]

In regard to Claims 8, 9, 10, 11, and 12 Yamagata et al discloses an reproducing apparatus with a detection circuit; however, lacks the detection circuit to be configured to do the following: encode the signal using a decryption key, exchange of authentication data between detection circuit and control circuit, encoding of the authentication data and producing signals when process is completed. Copeland et al discloses an apparatus for copy protecting various recording mediums wherein it has a detection circuit which is further configured to do the following:

- Produces a signal representative of the detection result, the detection circuit further configured to encode the signal using a decryption key, the control circuit further configured to receive the encoded signal and to decode the signal using the decryption key (Column 3 Lines 5-10 discuss the production of the signal that is representative of the detection results while Column 4 Lines 63+ describe the use of decryption for the encoded signal);
- Produces a signal representative of the detection result, wherein the detection circuit and the control circuit are further configured to exchange authentication data with each other, and wherein the detection circuit is further configured to deliver the signal to the control circuit when the detection circuit makes a positive determination that the control circuit is permitted (Column 4 lines 63+ describe the adding of the signal that represents the detection result “adding a video finger print signal to the input video..”. Furthermore it is described that the detection circuit and control circuit exchange the authentication signal as described in Column 5 Lines 34-53);

- Configured to encode the signal using the authentication data, and the control circuit is further configured to receive the encoded signal and to decode the signal using the authentication data (Figure 1 shows the authenticating signal generator 24 being used to encode the signal which is sent to the disc mastering device 16. The process is further described in Column 6 Lines 48-54);
- Produces a first/second signal when processing of data in the data store produces the detection result a first/second predetermined number of times in succession, the control circuit selectively outputting the first data in response to the first and second signals (Column 5 Lines 34-59 describe the producing of signals while storing one field and subtracting the other field from the second field. By subtracting two opposites the Video Finger Print Signals add and the video signal subtracts out which is integrated over a period of time which thereby produces a detection result for the first and second signals).

Therefore it would be obvious to one skilled in the art at the time of the invention to use the reproducing apparatus with detecting circuit, as disclosed by Yamagata et al, and incorporate a more detailed detection circuit which encode the signal using a decryption key and wherein the detection circuit and the control circuit are further configured to exchange authentication data with each other, as disclosed by Copeland et al. The addition of these elements would copy protect the data by giving it a video finger print and thereby allow the embedding of data not to deteriorate thereby allowing the embedded information to remain effective.

Conclusion

The prior art made of record and not relied upon are considered pertinent to applicant's disclosure. The following is considered of significant interest to the application:

- Ryan (US 5,513,260);
- Takahashi et al (US 5,680,500);
- Ogikubo (US 6,038,370);
- Nishiumi et al (US 5,881,204); and
- Takahashi (US 5,739,865).

Contact Fax Information

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

Or faxed to:

703.208.6306 (for formal communication intended for entry)
703.308.5359 (for informal or draft communications, please label "PROPOSED"
or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie J. Vent whose telephone number is (703) 305-0378.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Christopher Kelley, can be reached at (703) 305-4856.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jamie Vent

Miss Jamie Vent
06/14/2004

Chris Kelley

CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600